



Express Mail No. EU 982 568 016 US
Attorney Docket No. 027-040001US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 2874

Examiner: Daniel J. Petkovsek

Confirmation No. 2183

IN RE THE APPLICATION OF:

INVENTORS: Wil McCARTHY and Gary E. SNYDER

APPLICATION NO.: 09/964,927

FILING DATE: 26 SEPTEMBER 2001

TITLE: FIBER INCORPORATING QUANTUM DOTS AS
PROGRAMMABLE DOPANTS

CERTIFICATE OF MAILING BY EXPRESS MAIL

Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The undersigned hereby certifies that the attached

1. Third Amendment and Response to Final Office Action including corrections to Figs. 1, 2, 3A and 3B (13 pages);
2. Interview Summary including copy of Applicant Initiated Interview Request Form (4 pages).
3. Certificate of Mailing by "Express Mail" (37 CFR 1.10); and
4. Return postcard,

all relating to the above application were deposited as "Express Mail," Mailing Label No. EU 982 568 016 US, with the United States Postal Service, addressed to the above address, on 2 March 2004.

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INTERVIEW SUMMARY

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Signature: Adam Malmut
Name: Adam Malmut

Sir:

Pursuant to 37 C.F.R. § 1.133(b), the following is a summary of an interview between the undersigned and examiner Daniel J. Petkovsek that occurred on 23 February 2004. An Applicant Initiated Interview Request Form is enclosed herewith as the interview transpired contemporaneously with a scheduling request.

Applicants were confused about the basis for the rejection under 35 U.S.C. § 112, second paragraph asserted in the final Office action dated 2 January 2004.

First, Applicants noted the Office action states that claims 1-17 are indefinite because "there is no structure in the claim [sic] that would preclude the desired result(s) of claims 1-17."

Applicants explained that they did not want to preclude any results, but in fact the claimed structures were intended to achieve the desired results. Applicants questioned how this statement operated as a basis for the rejection. The examiner reiterated this statement and then allowed that he was not certain that it accurately conveyed what he meant to say.

Second, Applicants questioned the basis of the assertion in the Office action that the claims are “statements of desired results in the claims, and are not supported by any structural limitations in the claims.” Particularly, Applicants questioned why the examiner did not consider the terms “control path,” “quantum dot,” “energy,” and “artificial atom” as structures. Applicant discussed in particular that “control path” was a term defined in the specification that included many forms of energy carrying structures including wires, optical fibers, carbon, and other structures. The examiner allowed that perhaps “control path” was actually a structural limitation and that it was a choice as an example in the Office action, but he did not further elaborate with respect to the other structural limitations in the claims.

Third, Applicants questioned the statement in the Office action that “There is no reasonable description in the claims for how the device/method is composed, constructed, or functioned [sic].” Applicants pointed out that this is a legally improper premise. Applicants noted that the claims do not describe the invention, they define the bounds of the invention as described in the specification. A person of ordinary skill in the art is not supposed to reconstruct the invention based on the claims. The purpose of the written description, in part, is to enable the invention. Applicants noted that while the rejection as written in the Office action was based upon 35 U.S.C. § 112, second paragraph, these statements in the Office action, while legally inaccurate, appeared to be related to 35 U.S.C. § 112, first paragraph. The examiner offered no further explanation for the grounds of rejection. Applicants reminded the examiner that it was his burden to make an appropriate rejection and support it with factual evidence.

As the examiner offered no further explanation, Applicants indicated they would attempt to file a response to the final Office action addressing the grounds as best as could be understood, but indicated Applicants would not respond to rejections based upon legally improper grounds to avoid the possibility of unnecessary estoppel.

Respectfully submitted this 2nd day of March 2004.



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Docketing



Applicant Initiated Interview Request Form

Application No.: 09/964,927 First Named Applicant: McCarthy
Examiner: PETKOVSEK Art Unit: 2874 Status of Application: PENDING

Tentative Participants:

(1) DANIEL PETKOVSEK (2) BRAD HATTENBACH

(3) _____ (4) _____

Proposed Date of Interview: 2-23-04 Proposed Time: 9:00 (AM/PM)

Type of Interview Requested:

(1) Telephonic (2) Personal (3) Video Conference

Exhibit To Be Shown or Demonstrated: YES NO

If yes, provide brief description: _____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Rejection</u>	<u>1-17</u>	<u>N/A</u>	<input checked="" type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

Continuation Sheet Attached

Brief Description of Arguments to be Presented:

LACK OF CLARITY OF AND LACK OF FOUNDATION FOR REJECTIONS UNDER
§ 112 IN OFFICE ACTION

An interview was conducted on the above-identified application on 02-23-2004.

NOTE:

This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Brad Hattenbach
(Applicant/Applicant's Representative Signature)

(Examiner/SPE Signature)

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.